

RECEIVED  
CENTRAL FAX CENTER

DEC 17 2003

OFFICIAL

**BURGESS &  
BEREZNAK**800 West El Camino Real, Suite 180  
Mountain View, California 94040  
(650) 903-2264 (Telephone)  
(650) 903-2280 (Facsimile)A LIMITED LIABILITY  
PARTNERSHIP**FACSIMILE TRANSMITTAL SHEET (TRANSMITTAL TO PTO)**

Deliver to: Examiner Brian Miller- TC2600  
Firm Name: U.S. PATENT AND TRADEMARK OFFICE  
Fax Number: (703) 872-9315 Telephone No.: (703) 872-9313  
From: Bradley J. Berezna (Reg. No. 33,474)  
Date: Dec. 17, 2003 Time: 2:55 p.m. PST  
Operator: Caitlin Burgess Matter: 73600.P022  
Number of pages including cover sheet: 15  
In Re Patent Application of: Ueno, et al.  
Application No.: 09/479,267 Filed: January 06, 2000  
For: Spin-Valve Magnetoresistance Sensor and Thin Film Magnetic Head  
Enclosed are the following documents: Appeal Brief.  
Please call Bradley J. Berezna, should you have any questions regarding the above.

Respectfully Submitted,

Bradley J. Berezna**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office on:  
Date of Transmission Dec. 17, 2003  
Caitlin R. Burgess  
(Typed or printed name of person transmitting paper)



(Signature of person transmitting paper)

**CONFIDENTIALITY NOTE**

The documents accompanying this facsimile transmission contain information from the law firm of Burgess & Berezna, LLP that is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution, or use of the contents of this faxed information is prohibited. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.  
IF YOU EXPERIENCE ANY DIFFICULTY IN RECEIVING THE ABOVE PAGES, PLEASE CALL (650) 903-2264 AND ASK FOR THE OPERATOR NAMED ABOVE.

(Rev. 11/23/97)

27  
11/8/04  
RECEIVED  
CENTRAL FAX CENTER

Attorney Docket No. 073600.P022

PATENT

DEC 17 2003

OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

*UENO, et al.*

Serial No.: 09/479,267

Filing Date: January 06, 2000

For: SPIN-VALUE MAGNETORESISTANCE  
SENSOR AND THIN FILM MAGNETIC  
HEAD

) Appeal No. 2003-0594

) Examiner: Brian Miller

) Art Unit: 2652

**Appellant's Brief**  
**(35 CFR § 1.192)**Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant (Appellant) hereby respectfully submits this brief following receipt of the Notifications mailed 09/03/03 and 12/11/03 in connection with the above-referenced application on appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner of Group Art Unit 2652, dated June 08, 2001.

The Notification mailed 12/11/03 indicated that Appellant's Brief filed 9/29/03 was defective because there is no pending 35 U.S.C. § 102(e) rejection pending, therefore the issue should not be presented in the Appeal Brief. The Office Action mailed 4/03/02 stated two new grounds of rejection under 35

U.S.C. § 103(a), but included no indication that the previous grounds of rejection under 35 U.S.C. § 102(e) had been withdrawn. Apparently, that was the Examiner's intention in view of the most recently mailed Notification.

Accordingly, this brief does not include presentation of the issue of whether claims 1-4 should be anticipated under 35 U.S.C. § 102(e) in view of Aoshima.

An oral hearing is not requested.

**TABLE OF CONTENTS**

	<u>PAGE</u>
I. RELATED APPEALS .....	1
II. REAL PARTY IN INTEREST .....	1
III. STATUS OF THE CLAIMS .....	1
IV. STATUS OF AMENDMENTS .....	1
V. SUMMARY OF THE INVENTION .....	1
VI. ISSUES PRESENTED .....	3
VII. GROUPING OF CLAIMS .....	4
VIII. ARGUMENT .....	4
A. <i>PRIMA FACIE</i> OBVIOUSNESS DOES NOT EXIST WITH RESPECT TO THE REJECTION OF CLAIMS 1-4 .....	4
1. <u>An Ordinary Practitioner Would Have Lacked Motivation To Arrive            At The Claimed Invention In View Of Aoshima</u> .....	4
2. <u>An Ordinary Practitioner Would Have Lacked Motivation To            Modify Or Combine Aoshima And Iwasaki So As To Arrive At The            Invention Of Claims 1-4</u> .....	6
IX. CONCLUSION .....	9
APPENDIX .....	A1

**I. RELATED APPEALS**

Appellant is unaware of any related appeals or interferences.

**II. REAL PARTY IN INTEREST**

The real party in interest of Appellant is WESTERN DIGITAL CORPORATION.

**III. STATUS OF THE CLAIMS**

Claims 1-4 are pending in the application. No claims have been allowed.

Claims 1-4 stand rejected 35 U.S.C. § 103(a) as being unpatentable over Aoshima, taken alone, or, alternatively, in view of Iwasaki et al. (U.S. Patent No. 6,157,525; hereinafter Iwasaki).

**IV. STATUS OF AMENDMENTS**

No amendments have been filed after receipt of the Final Office Action.

**V. SUMMARY OF THE INVENTION**

The present invention relates to a spin-valve type magnetic resistance (MR) sensor for use in a thin-film type magnetic head. The spin-valve MR sensor is characterized by a structure in which a pair of magnetic layers is laminated on a substrate with a non-magnetic layer sandwiched in between to increase magnetic field sensitivity. The magnetization of one of the magnetic layers (commonly referred to as the "pin" layer) is fixed in the direction of the height of the element by an exchange-coupling magnetic field with an adjacent antiferromagnetic layer. The magnetization of the other magnetic layer (i.e., the "free" layer) can freely be caused to rotate by an external magnetic field. The angular difference in magnetization

direction arising between the two magnetic layers causes a change in the resistance of the MR film. Data recorded in the magnetic medium can be detected by means of this magnetoresistive change. (Specification page 1, line 10 through page 2, line 6; Figure 1)

The spin-valve type magnetic resistance sensor of the present invention is made up of layers (sometimes referred to as films) of different materials. The layers are stacked up as follows: insulating layer 1, first base film 21, second base film 22, nickel-iron film 41, cobalt-iron film 42, non-magnetic conducting layer 5, pinned magnetic layer 6, antiferromagnetic layer 7, protective layer 8, and alumina insulating layer 11. Layer 9 is a hard bias layer, and layer 10 is a conductive head. (Specification page 10, line 3 through page 11, line 14; Figure 1)

Each layer has properties determined by its material composition and crystalline orientation. The composition relates to the fundamental atomic elements in the film. Often, as in the Applicants' invention, the composition of elements naturally results in a crystalline structure that is a regular repeating arrangement of the elements. The orientation relates to the angle that such a crystal structure is situated. Composition and orientation are independent of each other; that is, a particular composition does not imply an orientation and a specific orientation does not imply a composition.

It is known in the magnetic recording arts that the characteristics of the antiferromagnetic material change depending on the material of the base layer. (Specification page 10, line 3 through page 11, line 14; Figure 1) Hence, the performance of a spin-valve MR sensor depends, in part, on the characteristics of the base layer material. In the prior art, for example, certain spin-valve MR sensors provided with a base layer comprising tantalum (Ta) suffer from unstable and unreliable magnetic transducing characteristics. (Specification page 3, line 9-15)

In order to raise reproduction output in a spin valve MR sensor it is also desirable to make the free magnetic layer as thin as possible. However, if the thickness of the free layer is reduced below a certain limit, the (111) crystalline orientation of the free layer becomes inadequate, so that reproduction output declines and the sensor becomes magnetically unstable. (Specification page 3, line 16 through page 4, line 4)

In accordance with the claimed subject matter, a MR sensor structure exhibiting improved performance with thermally and magnetically stabilized magnetic transducing characteristics is produced through the use of a base layer that includes a first film of a nonmagnetic metal and a second base film formed on the first base film. The second base film comprises an alloy NiFeX, where X includes one of Cr, Nb, or Rh. Importantly, the second base film has a face-centered cubic structure and a (111) orientation. (Specification page 8, line 11-21) By forming both magnetic layers, the nonmagnetic layer, and the antiferromagnetic layer of the spin valve film on top of the second base film, the (111) crystal plane orientation is strengthened, resulting in a spin-valve MR sensor that exhibits high relative magnetoresistive change. (Specification page 9, lines 1-7)

## VI. ISSUES PRESENTED

The issues presented on appeal are:

1. Whether claims 1-4 are unpatentable under 35 U.S.C. § 103(a) over Aoshima; and
2. Whether claims 1-4 are unpatentable under 35 U.S.C. § 103(a) over Aoshima in view of Iwasaki.

## VII. GROUPING OF CLAIMS

Claims 1-4 stand or fall together.

## VIII. ARGUMENT

### A. *PRIMA FACIE* OBVIOUSNESS DOES NOT EXIST WITH RESPECT TO THE REJECTION OF CLAIMS 1-4

*Prima facie* obviousness does not exist when the prior art fails to suggest or anticipate the benefits of modifying or combining references or when external factors, such as the changing state of the art, fail to provide motivation to one of ordinary skill in the art to make the modification or suggestion. Stated differently, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Here, the claimed invention (e.g., representative claim 1) taken as a whole cannot be said to be obvious because there is no reason given in the prior art why one of ordinary skill in the art would have been prompted to modify or combine the teachings of the references in the particular manner suggested by the Examiner to arrive at the subject matter of claims 1-4.

Applicant respectfully submits that a *prima facie* case of obviousness does not exist with respect to the rejection of claims 1-4 and respectfully traverses the rejection of claims 1-4 for lack of *prima facie* obviousness.

#### 1. An Ordinary Practitioner Would Have Lacked Motivation To Arrive At The Claimed Invention In View Of Aoshima

Aoshima teaches a magnetoresistive head comprising a bottom underlayer of Ta, a second underlayer composed of NiFeCr alloy, wherein Cr is in a range from 17



to 24.3 atomic percent, and an antiferromagnetic layer of PtMn formed on the second underlayer. Aoshima fails to expressly teach or disclose his second underlayer having a face-centered cubic (fcc) crystal lattice structure and a (111) crystal orientation, as recited in the claimed invention. Aoshima is silent as to the specific crystalline structure and orientation of his second underlayer.

In a particular embodiment, Aoshima discloses a spin valve magnetoresistive sensor 20, as shown primarily in Figs. 4 and 5, including: an underlayer 21 and underlayer 22 formed on top of a substrate (not shown, see col. 3, line 3); the underlayer 21 composed of a nonmagnetic metal (i.e., Ta) with the underlayer 22 composed of an alloy represented by NiFeX, wherein X includes one of Cr, Nb, Rh and Pd.

Aoshima does not teach, disclose, or suggest a second base film having a fcc structure and a (111) orientation, as recited in claim 1. Again, Aoshima is entirely silent as to the crystalline structure and orientation of his underlayer 22. He merely reports that his PdPtMn antiferromagnetic layer 23 becomes an ordered-alloy and has more fcc structure after going through an anneal process when it is formed on the Ta/NiFeCr underlayer arrangement. (Aoshima, col. 5, lines 1-21) There is no suggestion in the Aoshima patent to form a NiFeCr underlayer having a specific fcc crystalline structure and a specific (111) crystalline orientation. A specific structure in one layer does not necessarily imply or suggest a specific crystalline orientation in the same layer; nor does it suggest a particular structure or orientation in another layer. Because there is no teaching or suggestion of forming a NiFeCr underlayer with a fcc structure and (111) orientation, Applicant respectfully submits that the invention of claims 1-4 would not have been obvious to one of ordinary skill in the art at the time it was made.

2. An Ordinary Practitioner Would Have Lacked Motivation To Modify Or Combine Aoshima And Iwasaki So As To Arrive At The Invention Of Claims 1-4

The Examiner cites Iwasaki as disclosing that NiFeCr inherently has an fcc structure and (111) orientation (Iwasaki, col. 8, lines 32-36), and therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the NiFeCr underlayer disclosed in Aoshima such that it would have a fcc structure and (111) orientation, as taught by Iwasaki. Applicant respectfully disagrees and submits that the Examiner's citation of a single sentence in Iwasaki is taken out of context. Furthermore, it would not have provided any motivation or suggestion to an ordinary practitioner to arrive at the present invention. A single line in a prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness. *Bausch & Lomb, Inc. v. Barnes-Hind Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Iwasaki fails to disclose a NiFeCr film with a fcc structure *and* a (111) orientation. Instead, Iwasaki teaches that if a metal film is disposed on top of a Co based amorphous film, which is itself on top of a fcc magnetic film, that the underlying fcc magnetic film *promotes* the fcc (111) orientation of the metal film on top of the Co (Iwasaki, col. 8, lines 32-36).

The Examiner states that "the fcc structure in an (111) orientation is known to have a highly oriented crystal structure while no magnetic anisotropy appears in this orientation." The Examiner contends that these favorable characteristics would have been realized by a skill artisan. Applicant respectfully disagrees. Applicant contends that Aoshima and Iwasaki could only have been combined in the manner suggested by the Examiner through carefully considered hindsight using the present invention as a reconstructive guide. It is impermissible to use the claimed invention as an instructive manual or "template" to piece together the teachings of the prior art in

order to render the claimed invention obvious. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Applicant respectfully submits that the Examiner has used the patentee's claims as a "blueprint" in order to combine the right prior art references in the right ways to achieve the result of the claims in issue. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.").

In other words, there must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.").

Aoshima fails to teach, disclose, or suggest a spin valve MR sensor structure that includes first and second base layers, where the second base layer is composed of a NiFeX alloy, wherein X includes one of Cr, Nb and Rh, and where the second base layer has a fcc structure and a (111) orientation. Similarly, Iwasaki fails to disclose such a structure; nor does Iwasaki provide any teaching or suggestion that would have lead a person of ordinary skill to the claimed invention in view of Aoshima. Aoshima teaches a specific layering of materials in

his Figure 5. Iwasaki discloses a method for using a lower film to promote an orientation of an upper film. Iwasaki does not teach that if the upper film has this orientation, then the lower film must necessarily have the same specific orientation. Furthermore, there is nothing in either reference that suggests the combination of the two references in the manner suggested by the Examiner. That is, there is no teaching in the prior art that would have lead one of ordinary skill to combine or modify the Aoshima and Iwasaki references so as to arrived at the claimed invention.

Applicant respectfully submits that the rejection confuses structure and orientation. A specific layer structure does not necessarily imply a specific crystalline orientation, either in the same layer or in another layer. According to the Examiner, a fcc structure necessarily produces or requires a (111) orientation. A face centered cubic structure, as is well known, has four atoms per unit cell, six  $\frac{1}{2}$  atoms on each face, and eight  $\frac{1}{8}$  atoms at the corners. Additionally, the close-packed direction is (110). Importantly, these structural characteristics are completely independent of any orientation.

It is the burden of the Examiner to set forth a *prima facie* case of obviousness. To carry this burden the Examiner must establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). There has not been a *prima facie* showing in this case. The Examiner may not rely on a claim of inherency to establish a *prima facie* case of obviousness.

For all of the foregoing reasons, it is respectfully submitted that the rejection of claims 1-4 does not satisfy the criteria to establish *prima facie* obviousness.

**IX. CONCLUSION**

In sum, with no motivation or teaching that would lead one of ordinary skill to the concept of the present invention, Applicant respectfully submits that the present invention would not have been obvious to a person of ordinary skill in the art at the time it was made. Accordingly, applicant respectfully submits that the appealed claims in this application are patentable, and requests that the Board of Patent Appeals and Interferences direct allowance of rejected claims 1-4.